

UNITED STATES PATENT AND TRADEMARK OFFICE

MAILED

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U.S. PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SUBRAMANIA SUDHARSANAN,
JEFFREY MENG WAH CHAN, MICHAEL F. DEERING,
MARC TREMBLAY and SCOTT R. NELSON

Application 09/640,901

ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

This application was received electronically at the Board of Patent Appeals and Interferences on November 4, 2006. A review of the application has revealed that the application is not ready for docketing as an appeal. Accordingly, the application is herewith being electronically returned to the examiner. The matters requiring attention prior to docketing are identified below:

An examination of the Image File Wrapper (IFW) reveals that in the Final Rejection mailed October 19, 2004, the following rejections were made:

Claims 1-4, 18-21, 23-24, and 27-43 are rejected under 35 U.S.C. 102(e) as being anticipated by Kanakogi et al., U.S. Patent Number 6,609,143 (herein referred to as Kanakogi) [page 2]; and

Claims 22 and 25-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kanakogi in view of Oberman U.S. Patent Number 6,490,607 (herein referred to as Oberman) [page 9].

However, in the Examiner's Answer mailed May 5, 2006, the examiner lists the following rejections:

Claims 1, 2, 4, 18, 20, 21 and 27, 33-40¹ are rejected under 35 U.S.C. 102(e) as being anticipated by Kanakogi et al., U.S. Patent Number 6,609,143 (herein referred to as Kanakogi) [page 5]; and

Claim 22² is rejected under 35 U.S.C. 103(a) as being unpatentable over Kanakogi in view of Oberman U.S. Patent Number 6,490,607 (herein referred to as Oberman, with Hennessy cited for further extrinsic evidence [page 10].

It appears that the § 103(a) rejection of claim 22 listed above is a new ground of rejection.

¹ According to page 2 of the Examiner's Answer mailed May 5, 2006 under the caption "Status of Claims," claims 3, 19, 28-32, 41 and 42 have been cancelled, claims 23 and 24 have been objected to as being dependent upon a rejected base claim but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims, and claim 43 has been allowed.

² The rejection of claims 25 and 26 under 35 U.S.C. 103(a) as being unpatentable over Kanakogi in view of Oberman U.S. Patent Number 6,490,607 was withdrawn by the examiner. See page 4 of the Examiner's Answer mailed May 5, 2006.

37 CFR § 41.39 (2005) states:

§ 41.39 Examiner's answer.

(a)(1) The primary examiner may, within such time as may be directed by the Director, furnish a written answer to the appeal brief including such explanation of the invention claimed and of the references relied upon and grounds of rejection as may be necessary, supplying a copy to appellant. If the primary examiner determines that the appeal does not comply with the provisions of §§ 41.31 and 41.37 or does not relate to an appealable action, the primary examiner shall make such determination of record.

(2) An examiner's answer may include a new ground of rejection.

(b) If an examiner's answer contains a rejection designated as a new ground of rejection, appellant must within two months from the date of the examiner's answer exercise one of the following two options to avoid sua sponte dismissal of the appeal as to the claims subject to the new ground of rejection:

(1) Reopen prosecution. Request that prosecution be reopened before the primary examiner by filing a reply under § 1.111 of this title with or without amendment or submission of affidavits (§§ 1.130, 1.131 or 1.132 of this title) or other evidence. Any amendment or submission of affidavits or other evidence must be relevant to the new ground of rejection. A request that complies with this paragraph will be entered and the application or the patent under ex parte reexamination will be reconsidered by the examiner under the provisions of § 1.112 of this title. Any request that prosecution be reopened

under this paragraph will be treated as a request to withdraw the appeal.

(2) Maintain appeal. Request that the appeal be maintained by filing a reply brief as set forth in § 41.41. Such a reply brief must address each new ground of rejection as set forth in § 41.37(c)(1)(vii) and should follow the other requirements of a brief as set forth in § 41.37(c). A reply brief may not be accompanied by any amendment, affidavit (§§ 1.130, 1.131 or 1.132 of this title) or other evidence. If a reply brief filed pursuant to this section is accompanied by any amendment, affidavit or other evidence, it shall be treated as a request that prosecution be reopened before the primary examiner under paragraph (b)(1) of this section.

(c) Extensions of time under § 1.136(a) of this title for patent applications are not applicable to the time period set forth in this section. See § 1.136(b) of this title for extensions of time to reply for patent applications and § 1.550(c) of this title for extensions of time to reply for ex parte reexamination proceedings.

In order to include a new ground of rejection in the Examiner's Answer, the examiner must follow the guidelines set forth in training material entitled "Rules of Practice Before the Board of Patent Appeals and Interferences, Final Rule," located at the following URL:

www.uspto.gov/web/offices/dcom/bpai/fr2004/moreinfo.html

The requirements for a new ground of rejection are:

- 1) Approval by a Technology Center Director or designee; and

2) Prominently identified, by a separate heading with all capital letters in the following sections of the Examiner's Answer:

Grounds of Rejection to be Reviewed on Appeal section, and

Grounds of Rejection section.

To correct this problem, the examiner will need to vacate the Examiner's Answer mailed May 5, 2006. Once the Examiner's Answer mailed May 5, 2006 is vacated, the examiner has the following options:

- 1) to write a new Examiner's Answer without the new grounds of rejection;
- 2) to reopen prosecution; or
- 3) to write a new Examiner's Answer properly setting forth the new grounds of rejection.

In addition, we are unable to find a copy of the Hennessy et al. reference (Computer Architecture – A Quantitative Approach, second edition, pages 102 and 103) which was included in the § 103(a) rejection of claim 22 on page 10 of the Examiner's Answer mailed May 5, 2006.

Accordingly, it is

ORDERED that the application is returned to the examiner to:

- 1) vacate the Examiner's Answer mailed May 5, 2006;

- 2) to select one of the following options:
 - a) reopen prosecution;
 - b) write a new Examiner's Answer without the new grounds of rejection; or
 - c) write a new Examiner's Answer properly setting forth the new ground of rejection;
- 3) to locate a copy of the missing Hennessy reference and have a complete copy scanned into the IFW; and
- 4) for such further action as may be appropriate.

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